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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,408	08/30/2001	Akito Kohno	393032027800	3181
25224 7590 02/02/2009 MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024				
EXAMINER				
FAULK, DEVONA E				
ART UNIT		PAPER NUMBER		
2614				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/945,408

**Applicant(s)**

KOHNO ET AL.

**Examiner**

DEVONA E. FAULK

**Art Unit**

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5, 8, 11 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5, 8 and 14 is/are allowed.
- 6) ☒ Claim(s) 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/30/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. The applicant has cancelled the claims that were rejected in the previous office action. The claims that remain were indicated as allowable. Claims 5,8 and 14 remain in allowable form. Claim 11 has to be rejected under 101 because of the recent Federal Circuit decisions indicated that a statutory process must be tied to another statutory category.

2. Claims 1-4,6-7,9-10,12-13,15-16 are cancelled.

### ***Claim Objections***

3. The applicant has indicated that claims 10-11 are cancelled. The examiner asserts that this is in error and that it should state that claims 9-10 are cancelled. Claim 11 has not been cancelled. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

Claim(s) **11** is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions<sup>2</sup> indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory

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<sup>1</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. The applicant has not tied the steps of "inputting", "mixing" or "storing", "assigning" and "controlling", to another statutory category

***Allowable Subject Matter***

4. Claim 11 would be allowable if rewritten to overcome the 101 rejection set forth above.
5. Claims 5,8,14 are allowed.

Regarding claims 5,8 and 14 prior art Powers, US 6, 839,441, discloses a sound mixing console with master control section including an input device that inputs a plurality of first audio data, an assigning device, a storage device. Prior art Tanji (JP 10-320-194) discloses an effect giving device and recording medium. Prior art Yamamoto, US 5,942,708, discloses a tone generator with diversification of waveform using variable addressing including an input device, a hard disk drive, a plurality of operating members an assigning device, a memory, a control device. Prior art Saito, US 6,198,035, discloses a musical sound signal generation apparatus. Prior art East, US 6,061,458, discloses an audio mixing console. Prior art Ito, US 5,300,723, discloses an electronic music device including a switch panel and a switch detection circuit. Prior art Suzuki et al., US 5,831,193, discloses a method and device for forming a tone waveform by combined use of different waveform sample forming resolutions including a hard disk drive, a RAM having a working memory. Prior art Haruyama, US 5,902,948, discloses

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a performance-instructing device including a RAM memory that temporarily stores automatic performance data, and a switch panel and a switch-detecting panel. Prior art Kondo et al., US 5,668,337 discloses an automatic performance device including a display including a channel change table used to assign data to certain channel, a switch operation detection circuit. Prior art Yamamoto et al, US 6,573,444, discloses a music data compression apparatus and method including a hard disk drive having a primary memory that temporarily stores musical pieces recorded on a music CD and when a user presses a digital dubbing key the data stored in the primary memory, compressed and the compressed data is stored in a secondary memory.

Regarding claim 5, the prior art or combination thereof fails to disclose or make obvious "an assigning device that assigns at least one of the plurality of second audio data stored in said built-in hard disk device and at least one of the plurality of third audio data stored in said external storage device respectively to at least one of said plurality of operating members" and "said control device that is responsive to said assigning device assigning the third audio data, respectively, to the at least one of said plurality of operating members, for causing said built-in hard disk device to temporarily store the assigned second audio data and causing said memory to store the assigned third audio data, said control device being further responsive to said assigning devices assigning the second audio data, respectively, to the at least one of said plurality of operating members, for reading out the assigned second audio data from said built-in hard disk device and causing said memory to temporarily store the assigned second audio data without double storing the assigned second audio data in said built-in hard disk".

Regarding claim 14, the prior art or combination thereof fails to disclose or make obvious and "using a controlling module to cause, in response to assigning the third audio data, respectively, to the at least one of said plurality of operating members in said assigning module, the built-in hard disk to temporarily store the assigned second audio data and causing said memory to store the assigned third audio data, and reading out, in response to assigning the second audio data, respectively, to the at least one of said plurality of operating members in said assigning module, the assigned second audio data from the built-in hard disk device and causing the memory to temporarily store the assigned second audio data without double storing the assigned second audio data in the built-in hard disk. . Therefore the prior art or combination thereof fails to disclose or make obvious a mixing device and method as claimed.

**Claim 8** is allowed due to dependency on claim 5.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEVONA E. FAULK whose telephone number is (571)272-7515. The examiner can normally be reached on 8 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 571-272-7848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Devona E. Faulk/  
Examiner, Art Unit 2614